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TM

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/813,852 03/07/97 DOCKERY

R 21651.3

EXAMINER

PM92/1022

BARTUSKA, F

ART UNIT

PAPER NUMBER

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3652

DATE MAILED:

13
10/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/813852

Applicant(s)

R.L. DOCKERY et al

Examiner

F. J. BARTUSKA

Group Art Unit

3652

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on Sept. 3, 1999
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 4, 10 AND 17 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 4, 10 AND 17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication. Tai discloses delivery of coupons in magazines and newspapers in col. 1, lines 26-49; magazines and newspapers

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include non-product information attractive to customers. The coupons in Tai are directed to brand name products, see col.1, line 32. Tai does not disclose displaying the magazines or newspapers in the store. The "Retailing" publication discloses displaying magazines next to the check-out counter in lines 46-49 of the first column of page 19. It would have been obvious to one of ordinary skill in the art to display the magazines and coupons of Tai in a store in view of the showing and teaching of the "Retailing" publication.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above. Further, merely calling for the store colors to be on the coupons would involve only a notorious expedient of the art especially in the situation in which the coupon is for a brand which is exclusive to a store.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above. Further, it would have been obvious to one of ordinary skill in the art in view of the teaching on page 20 in lines 28-40 of the first column of the "Retailing" publication to include recipes in magazine advertisements of food, which advertisements include the coupons of Tai.

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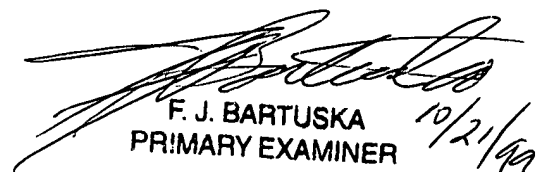
5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above, and further in view of Degasperi et al. Tai, as modified by the "Retailing" publication, shows all the features of the applicant's claimed invention except locating the products near the publication. Degasperi et al teach that coupons are used most often when placed near the products. It would have been obvious to one of ordinary skill in the art in view of the teaching in Degasperi et al to locate the products near the magazines with coupons of Tai.

Response to Arguments

6. The applicant's remarks have been considered but have not been found persuasive because the recipes mentioned in the "Retailing" publication would contain brand names, such as: "Carnation" milk..

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. Bartuska whose telephone number is (703) 308-1111.


F. J. BARTUSKA
PRIMARY EXAMINER 10/21/99